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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,937	03/22/2000	Stefan Georg Hild	RSW9-99-132	9182

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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/532,937

Applicant(s)

HILD ET AL.

Examiner

David E. England

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Response to Arguments.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-36

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____


DAVID WILEY
SUPERVISORY PATENT EXAMINER
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Response to Arguments

1. Applicant's arguments filed 10/02/2003 have been fully considered but they are not persuasive.

2. In the remarks, Applicant argued in substance that the claims 31, 33 and 35 are in proper dependent form and the objections to the claims are improper in that claims 1, 11 and 22 do not specifically recite actually "customizing the requested document" as recited in claims 31, 33 and 35.

3. As to part 1, Examiner would like to point out a sentence stated by the Applicant that explains the limitation in question of Claims 1, 11 and 22,

4. "Claims 1, 11 and 22 recite, "inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document." In other words, the at least one of plurality of requested client properties is inserted into the request and may be used to customize the requested document."

5. If the customization may be used, as stated by Applicant, it would be interpreted that the customization of the requested document could be run or doesn't have to be run. Given the explanation that the Applicant has given and the interpretation of the claims in the broadest aspect that the limitation language allows, the act of customizing is covered in claims 1, 11 and 22, whether or not the act of customizing is done, the limitation and explanation from the Applicant states that it can be done. Therefore, claims 31, 33 and 35 do not further limit claims 1, 11 and 22 respectively. Objection still stands from the Final Office Action mailed 07/30/2003.

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6. In the remarks, Applicant argued in substance that there is no motivation or suggestion to combine the cited references as suggested in the Final Office Action. As recently affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority.**

The Final Office Action must point to a specific portion of the cited references that would induce on of skill in the art to combine the cited references as suggested in the Final Office Action

7. As to part 2, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Examiner has stated an obvious reason as to why and an example why one would request hardware characteristics from the client. Restated:

1. "It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because having hardware as at least one requested client property could aid in the transmission, storage and compatibility of the system that is transmitting the client information. For example, if a client wanted to download information after accessing a link and the user didn't have a fast enough transmission median, the server from which the download is coming from would know this from the transmitted hardware information that was requested from the client, therefore the server

could make the necessary changes to make sure that the download transmits successfully without error or deny the client altogether.”

8. This type of utilization of the limitation that is commonly used with Internet sites that request the download speed of the users computer. If the Applicant has different uses for the limitation of claims 32, 34 and 36 then it would be in the best interest of the Applicant to state a limitation that teaches a different reason for “requested client properties is associated with hardware characteristics of the client.” Doing so could overcome the references but would require further search and consideration.

9. Furthermore, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

10. Furthermore, the Applicant quotes *In re Sang-su Lee*, where a factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown

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authority. The two sections that are under *In re Sang-su Lee* (Fed. Cir. 2002) are MPEP 2143.01 and 2144.03. MPEP 2143.01:

11. There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and **the knowledge of persons of ordinary skill in the art.**” In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457- 58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int ’l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

12. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000),

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13. and MPEP 2144.03, which deal with an Official Notice, which is not the case in the rejection:

14. In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on “common knowledge” in making a rejection, however such rejections should be judiciously applied.

15. Rejection of claims 32, 34 and 36 still stand.

16. In the remarks, Applicant argued in substance that Merriman does not teach the limitation of claims 1, 11 and 22 wherein receiving a link element associated with a server, the link element **including a plurality of requested client properties** and inserting at least one of said plurality of requested client properties into the request **so to allow customization of the requested document** identified by the link element based on the inserted at least one of requested client properties. In other words, according to embodiments of the present invention, the server receives the information it requests, not a dump of all “the information known about the user.”

17. As to part 3, Examiner would like to point out that the sections quoted by the Examiner do teach what is described above in the claimed limitation language. If the request is for all the information then the system will provide all the information that will be used. The claim language does not state in anyway that there is a limit as to how much information the system can request. Therefore, the reference of Merriman teaches the limitation language that is stated above in the referenced areas stated in Final Office Action. If the Applicant amended the claim language to remedy this limitation, it would require further search and consideration.

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18. Furthermore, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

19. In the remarks, Applicant argued in substance that according to the Federal Circuit, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01.

20. As to part 4, the Examiner would like to draw the Applicant's attention to what is stated above in parts 1 and 2. Parts 1 and 2 are similar to part 4 and will be used for similar reasons.

21. All objections and rejections still stand as stated in Final Office Action.